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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/739,771	12/20/2000	Jean-Charles Javerlhac	108154.01	5446

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EXAMINER

PORTER, RACHEL L

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 03/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/739,771

Applicant(s)

JAVERLHAC, JEAN-CHARLES

Examiner

Rachel L. Porter

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 21-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 21-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/26/2005</u> | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 12/13/04. Claims 1-19 and 21-33 are pending. Claim 20 has been canceled. The IDS filed 1/26/05 has been entered and considered.

Claim Objections

2. The objection to claim 18 is hereby withdrawn due to the amendment filed 12/13/04.

Claim Rejections - 35 USC § 101

3. The rejections of claims 1-20 under 35 USC § 101 is hereby withdrawn due to the amendment filed 12/13/04.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4,7-10,13-19,21-24,27-29, and 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable Joao (USPN 6,347,302) and Payne (USPN 6,049,772).

[claims 1] Joao teaches an insurance method comprising:

- establishing a contract between a client having a property to be insured and an insurer ready to insure the client against possible claims concerning the property,

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- in which contract the client pays the insurer an initial sum covering at least the costs of insurance over a predetermined duration; (col. 14, lines 5-28, lines 38-45)
- insuring the property to be insured using the initial sum; (col. 14, lines 37-45)
 - at the end of the said predetermined duration, computing using data processor means computed sum being computed as a function of a number of the claims concerning the property; and (Figures 4A and 4B; col. 15, lines 25-35)
 - reimbursing the computed sum to the client. (col. 15, lines 17-35)

Joao teaches a system for insuring property and providing rebates to the insured as explained above, but does not expressly disclose that the sum paid by the insured is invested or that the money reimbursed to the insured is computed as a function of the income earned by the investment made by the insurer. Payne discloses a system/method in which the client pays the insurer an initial sum covering at least the costs of insurance over a predetermined duration and investing a portion of the initial sum so that the invested sum earns income (Col. 2, Ln. 30-50 and Figure 2). Moreover, Payne discloses that the policy accumulates a cash value, which may be surrendered/reimbursed to the customer (i.e. a method wherein the sum returned to the customer is computed as a function of the income earned by insurer on the investment). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/method of Joao with the teaching of Payne to invest the sum paid by the insured and to use the amount of income earned on the investment to compute the amount returned to the insured at the end of a predetermined period.

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As suggested by Joao, one would have been motivated to include this feature to reward individuals who maintain property well, causing minimum damage and costs to the insuring entity. (col. 4, lines 1-19)

[claim 2-3] Joao and Payne teaches an insurance method according to claim 1.

Furthermore Joao teaches a method in which the computed sum corresponds, to an increased amount being returned to the insured (col. 13, line 54-col. 14, line 4). Joao does not expressly disclose that the computed sum (returned to the customer) corresponds to the fraction of the income earned by the investment.

Payne discloses a system/method wherein the computed sum corresponds to of the fraction of the income earned by the investment. The concept of cash surrender value indicates that the cash value of the policy increases as the number of claims decrease and if there are no claims then a major fraction of the income earned by the investment is returned (i.e. if there are no claims the investment income is not used to pay these claims so a greater portion of it can be returned to the client). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/method of Joao with the teaching of Payne to invest the sum paid by the insured and to use the amount of income earned on the investment to compute the amount returned to the insured at the end of a predetermined period. As suggested by Joao, one would have been motivated to include this feature to reward individuals who maintain property well, causing minimum damage and costs to the insuring entity. (col. 4, lines 1-19)

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[claim 4] Joao and Payne teach the method of claim 1 as explained in the rejection of claim 1. Joao does not expressly disclose the investment of the premium and as such does not disclose a guaranteed minimum rate. Payne discloses a method in which the investment is guaranteed at a minimum rate (Col. 3, Ln. 26-27). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/method of Joao with the teaching of Payne to invest the sum paid by the insured at a guaranteed rate. As suggested by Joao, one would have been motivated to include this feature to reward individuals who maintain property well and cause minimum damage and costs to the insuring entity (col. 4, lines 1-19), while ensuring that the promised reimbursement will be available to qualifying customers.

[claim 7] Joao and Payne teach an insurance method according to claim 1 as explained in the rejection of claim 1. Joao does not expressly disclose a predetermined duration for compliance with legislation. Payne discloses a system in which the predetermined duration is longer than a determined duration set by legislation and enabling a tax advantage to be obtained. (col. 1, lines 20-26; col. 3, lines 37-41) At the time of the Applicant invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Joao with the teaching of Payne. As suggested by Payne, would have been motivated to include this feature to for provide financial benefits to the participating companies. (col. 1, lines 20-26)

[claims 8-9] Joao teach the method of claim 1 as explained in the rejection of claim 1. Furthermore, Joao teaches an insurance method wherein the insured's contract allows the insured to paid/reimbursed based at least in part upon claims history. (col. 15, lines

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25-35) However, Joao does not expressly disclose how this payment occurs. Payne discloses a method/system wherein the insured may be paid in lump sum (i.e. cash surrender) or by annuity. (col. 2, lines 41-50) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Joao with teachings of Payne to allow the insured to receive payment as either a lump sum or as an annuity. One would have been motivated to include this feature to provides insurance incentives to the insured, while also accommodating his or her financial needs. (Payne: col. 1, lines 20-26; 59-65)

[claim 10] Joao teaches an insurance method in which the property is selected from vehicles, boats, leisure property, real property belonging to the client or occupied by the client; and professional property. (Joao: col. 5, lines 63-col. 6, line 6)

[claims 13-14] Joao and Payne teach the method of claim 1 as explained in the rejection of claim 1. Joao does not expressly disclose the advantages of various contract durations. Payne discloses a method/system wherein the contract term is longer than one year (col. 4, lines 54-59) and wherein different terms have different advantages. (col. 4, lines 54-67). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to further modify the method/system of Joao and Payne in combination so that different contract lengths (e.g. greater than one year) may be obtained for the investment of the initial sum payment. One would have been motivated to include this feature to stabilize the investment risk by increasing its time span.

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[claim 15] Joao teaches method, wherein the insurer makes a present to the client of at least a portion of the costs of insurance in the absence of any claim. (col. 15, lines 25-45)

[claim 16] Joao and Payne teach the method of claim 1 as explained in the rejection of claim 1. Joao further discloses that the client may be a business entity (col. 7, lines 15-22), but does not expressly disclose that it is a reinsurance company. Payne discloses that it is common for an insurance company client seeks reinsurance with another insurance company. (col. 3, lines 63-65) At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art to further modify the method of Joao and Payne in combination to allow the client to be an insurance company seeking reinsurance. One would have been motivated to include this feature to allow the client insurance company to mitigate its risks with a reinsurer in order to provide a financial safety net for its clients.

[claim 17-18] Joao teaches a method of insuring an apparatus for locomotion on land, in the air, or at sea, the method comprising the following steps:

- paying to the insurer in addition to the purchase or rental of the vehicle, a initial sum that is greater than or equal to the costs of insurance during a predetermined period; (col. 14, lines 5-28, lines 38-45)
- insuring the vehicle using the initial sum; (col. 14, lines 37-45)
- returning, in the absence of a claim and at the end of the predetermined period, the calculated sum to the client. (col. 15, lines 17-35)

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Joao teaches a system for insuring property and providing rebates to the insured as explained above, but does not expressly disclose that the sum paid by the insured is invested or that the money reimbursed to the insured is computed as a function of the income earned by the investment made by the insurer. Payne discloses a system/method in which the client pays the insurer an initial sum covering at least the costs of insurance over a predetermined duration and investing a portion of the initial sum so that the invested sum earns income (Col. 2, Ln. 30-50 and Figure 2). Moreover, Payne discloses that the policy accumulates a cash value, which may be surrendered/reimbursed to the customer (i.e. a method wherein the sum returned to the customer is computed as a function of the income earned by insurer on the investment). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/method of Joao with the teaching of Payne to invest the sum paid by the insured and to use the amount of income earned on the investment to compute the amount returned to the insured at the end of a predetermined period. As suggested by Joao, one would have been motivated to include this feature to reward individuals who maintain property well, causing minimum damage and costs to the insuring entity. (col. 4, lines 1-19)

[claim 19] Joao teaches a system for issuing an insurance policy, the system comprising:

- means for inputting a duration of a contract; (Figures 2A-2B; 4A-4B; col. 13, lines 47-col. 14, line 6)

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- means for inputting a nature of a property to be insured; (Fig. 4A-4B; col. 13, lines 47-col. 14, line 6)
- means for calculating the total of the premiums due during the duration of the contract, as a function of the nature of the property to be insured; (Figures 2A-2B; col. 14, lines 2-28)
- means for inputting an amount of an initial sum paid by a client; (col. 14, lines 49-65)
- means for determining information relating to earnings that can be made to the advantage of the client as a function of the number of claims concerning the property the insurer would have to indemnify during the duration of the contract; (col. 14, lines 48)
- means for delivering the information to the client (Figure 1; col. 5, lines 40-58)
- means for printing an insurance policy including at least the duration of the contract, the amount of the initial sum paid by the client, the nature of the property (Fig. 1; col. 5, lines 40-58; col. 14, lines 5-28)

Joao teaches a system for insuring property and providing rebates to the insured as explained above, but does not expressly disclose that the sum paid by the insured is invested or that the money reimbursed to the insured is computed as a function of the income earned by the investment made by the insurer. As such, Joao does not disclose the details of disclosing investment advantages to the client. Payne discloses a system/method in which the client pays the insurer an initial sum for insurance costs duration and investing a portion of the initial sum so that the invested sum earns income

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(Col. 2, Ln. 30-50 and Figure 2). Moreover, Payne discloses that the policy accumulates a cash value, which may be surrendered/reimbursed to the customer (i.e. a method wherein the sum returned to the customer is computed as a function of the income earned by insurer on the investment). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the system/method of Joao with the teaching of Payne to invest the sum paid by the insured and to use the amount of income earned on the investment to compute the amount returned to the insured at the end of a predetermined period. As suggested by Joao, one would have been motivated to include this feature to provide greater incentive to individuals to individuals to maintain property well, and minimize damage and costs to the insuring entity. (col. 4, lines 1-19)

[claim 21] The limitations of claim 21 are substantially similar to those recited in claim 1. As such, claim 21 is rejected for the reasons provided in the rejection of claim 1 and incorporated herein.

[claims 22-23] The limitations of claim 22 and 23 are substantially similar to those recited in claims 2 and 3 respectively. As such, claims 22-23 are rejected for the reasons provided in the rejections of claims 2,3, and 21, and incorporated herein.

[claim 24] The limitations of claim 24 are addressed by the rejections of claims 4 and 21, and incorporated herein.

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[claims 27-28] Joao teach the method of claim 21 as explained in the rejection of claim 21. Furthermore, Joao teaches an insurance method wherein the insured's contract allows the insured to paid/reimbursed based at least in part upon claims history. (col. 15, lines 25-35) However, Joao does not expressly disclose how this payment occurs. Payne discloses a method/system wherein the insured may be paid in lump sum (i.e. cash surrender) or by annuity. (col. 2, lines 41-50) At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to modify the teachings of Joao with teachings of Payne to allow the insured to receive payment as either a lump sum or as an annuity. One would have been motivated to include this feature to provide insurance incentives to the insured, while also accommodating his or her financial needs. (Payne: col. 1, lines 59-65)

[claim 29] Joao teaches a system in which the property is selected from vehicles, boats, leisure property, real property belonging to the client or occupied by the client; and professional property. (Joao: col. 5, lines 63-col. 6, line 6)

[claims 32-33] Joao and Payne teach the method of claim 21 as explained in the rejection of claim 21. Joao does not expressly disclose the advantages of various contract durations. Payne discloses a method/system wherein the contract term is longer than one year (col. 4, lines 54-59) and wherein different terms have different advantages. (col. 4, lines 54-67). At the time of the Applicant's invention, it would have been obvious to one of ordinary skill in the art to further modify the method/system of

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Joao and Payne in combination so that different contract lengths (e.g. greater than one year) may be obtained for the investment of the initial sum payment. One would have been motivated to include this feature to stabilize the investment risk by increasing its time span.

6. Claims 5-6 and 25-26 are rejected under 35 U.S.C. 103(a) as being unpatentable Joao and Payne, in further view of McMillan et al (USPN 6,064,970).

[claims 5-6] Joao and Payne teach the method of claim 1 as explained in the rejection of claim 1. Joao and Payne do not disclose that the client is given the option of signing an addition to the contract while it is in force to enable the client to pay an additional sum in the event of the risk increasing and to withdraw a sum in the event of the risk decreasing.

McMillan discloses insurance rating systems that provide discounts and surcharges and different premiums being charged based on changes that occur during the contract, such as a driver's age (col. 2, lines 13-37 of McMillan). At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the method of Joao and Payne in combination with the features of McMillan. As suggested by McMillan, one would have been motivated to include these features to assess the likelihood of a claim subsequently occurring and charging premiums accordingly. (col. 2, lines 42-43; col. 4, line 59-col. 5, line 12 of McMillan).

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[claims 25-26] The limitations of these claims are addressed by the rejections of claims 5-6 and 21.

7. Claims 11-12 and 30-31 are rejected under 35 U.S.C. 103(a) as being unpatentable Joao and Payne, in further view of Cooperstein (USPN 5,893,071).

[claims 11-12] Joao and Payne disclose the method of claim 1 as explained in rejection of claim 1. However, Joao and Payne in combination do not expressly disclose the recited details of initial sum paid by client.

Cooperstein discloses that the initial sum paid by the client is greater than the total of the premiums paid in advance and that the initial sum paid by the client is less than the total of the premiums due during the period of the contract, with at least a fraction of the earnings being used to pay at least a fraction of the premiums (Fig. 8 and col. 1, line 62 - col. 2, line 7 of Cooperstein).

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the method of Joao and Payne in combination with the teachings of Cooperstein. One would have been motivated to include these features to protect an insured individual from adverse financial consequences (col. 1, lines 22-24 of Cooperstein).

[claims 30-31] The limitations of claims 30 and 31 are addressed by the rejection of claims 11-12 and 21, and incorporated herein.

Response to Arguments

8. Applicant's arguments filed 12/13/04 with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

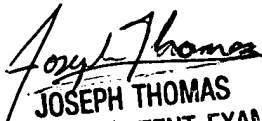
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachel L. Porter whose telephone number is 703-305-0108. The examiner can normally be reached on M-F, 9:30-6:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (703) 305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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